

SUMMARY

The present Request for Reconsideration and following remarks are responsive to the points raised in the December 9, 2005 Office Action. In the Office Action, claims 1-7 and 9-15 were rejected as final under 35 U.S.C. § 103(a) as being unpatentable over *Chou* (U.S. Patent No. 6,017,140) in view of *Johnson et al.* (U.S. Patent No. 4,255,746). Claim 8 was rejected as final under 35 U.S.C. § 103(a) as being unpatentable over *Chou* and *Johnson et al.* and further in view of *Schmidt* (U.S. Patent No. 4,290,095). Upon entry of this Request for Reconsideration, claims 1-15 will remain pending in this application. Entry and consideration of this Request for Reconsideration are respectfully requested.

REMARKS

Claims 1-7 and 9-15 were rejected as final under 35 U.S.C. § 103(a) as being unpatentable over *Chou* in view of *Johnson et al.* Claim 8 was rejected as final under 35 U.S.C. § 103(a) as being unpatentable over *Chou* and *Johnson et al.* and further in view of *Schmidt*. Applicant continues to traverse these rejections for at least the following three reasons: 1) the pending claims define over the proposed combination of *Chou* and *Johnson et al.*, 2) one of ordinary skill in the art of bicycle lamps would not have referred to *Johnson et al.* to modify *Chou*, and 3) the proposed combination, even if made, would still fail to teach each and every claim element.

1) The pending claims define over the proposed combination of *Chou* and *Johnson et al.*:

The pending claims are directed to a safety light that monitors battery power with a sensor that is capable of automatically switching the safety light from operation of the primary power source, a main light bulb, to operation of a secondary light that draws less power from the battery to provide, among other things, safety lighting for an extended period of time. Neither *Chou*,

Johnson et al., any other cited art, nor any combination of any of the cited art provides a sensor that automatically switches from operation of a primary bulb to operation of a secondary bulb. *Chou* appears to provide a bicycle lamp with a control switch capable of being operated manually by a user through a cycle of lighting options, e.g. switching from a high-beam light to a low-beam light. The lamp of *Chou* also appears to provide an indication LED to inform a user if the batteries have insufficient power. However, as agreed by the Examiner, *Chou* fails to provide a sensor that monitors available power and that automatically switches to a light that requires less power. Further still, *Chou* fails to provide a teaching or suggestion to modify the manual switch to automate monitoring power and switching from a high power to a low power draw light source. In fact, no reference cited provides a motivation, teaching, or suggestion to modify the lamp of *Chou* to automate monitoring power and switching from a high power to a low power draw light source to reach the pending claims. *Johnson et al.*, in specific, fails to provide such motivation, teaching, or suggestion to modify *Chou* to reach the pending claims.

2) One of ordinary skill in the art would not have referred to *Johnson et al.* to modify *Chou*:

One of ordinary skill in the art would not be motivated to use, or even find, *Johnson et al.* to apply the teachings therein to modify *Chou* to reach the present claims. *Johnson et al.* provides an emergency lighting and fire detector system. The system of *Johnson et al.* appears to be hard-wired into a housing wall and connected to a continuous power source with a rechargeable battery backup to operate the fire detector of *Johnson*, for example during a power outage. *Johnson et al.* provides a low voltage dropout system 50 that determines when the voltage of battery 46 has dropped below a predetermined level and opens a switch 45 to shut off auxiliary light 12. After shutting off light 12, the dropout system 50 then pulses a switch 48 to activate an audible alarm 49 to produce a continuous intermittent beep to notify a user that the

battery is worn out or defective and will not hold a charge. However, *Johnson et al.* fails to provide a motivation, teaching, or suggestion to modify *Chou* to reach the pending claims.

3) Even if made, the proposed combination fails to teach each and every claim element:

The pending claims are not taught or suggested by the combination of these two references since any resulting combination would not provide all elements as claimed herein. *Johnson et al.* fails entirely to disclose a sensor that switches from operation of a primary light bulb to a secondary bulb that draws less power. At best, *Johnson et al.* provides a teaching of switching off a light source and activating an audible alarm. Armed with this teaching of *Johnson*, one of ordinary skill in the art would be unable to modify the multi-functional bicycle lamp of *Chou* to reach the claimed invention. In fact, combining the teachings of *Johnson et al.* with *Chou* would result in a lamp that switches off the light source and emits an audible alarm when the battery level dropped below a predetermined threshold. Such a combination not only fails to teach each and every aspect of the pending claims (continues to lack a sensor that switches from a primary bulb to a secondary bulb automatically), but also would result in a combination that would not provide a safety light (an audible alarm will not light one's path for safety).

Further still, the combination of *Chou* and *Johnson et al.* cannot be performed without undue modification of *Chou*. *Chou* provides a lamp operated by a switch to allow a user to cycle through several operational modes of the lamp. *Chou* fails entirely to teach or suggest modification of the lamp to provide switching from one mode of operation to another without physical intervention by a user. One of ordinary skill in the art armed with the portable light of *Chou* would not be motivated to look to the non-portable, fire detector system of *Johnson et al.* to reach the claimed invention – especially since the combination of *Chou* and *Johnson* fails to

meet all limitations of the claimed invention. Specifically, the Examiner has failed to address how the low voltage dropout system 50 of *Johnson et al.* would be installed and used in the *Chou* lamp. Accordingly, since *Chou* fails to teach or suggest modification of the lamp therein and since all operation of the *Chou* lamp is performed by manually pressing a switch, one of ordinary skill in the art would not be motivated to combine *Chou* with *Johnson et al.* Further still, the prior art must suggest the desirability of the claimed invention (MPEP 2143.01), which is lacking in the proposed combination of *Chou* and *Johnson et al.*.

In fact, *Chou* and *Johnson et al.* cannot be combined without rendering *Chou* unsatisfactory for its intended purpose or without changing the principal of operation of *Chou*, in violation of MPEP § 2143.01. *Chou* fails entirely to provide for switching automatically from one mode of operation to another, for monitoring battery power, or for switching operation from one mode to another based on input regarding battery power. *Johnson et al.* fails to provide a teaching or suggestion for modifying a bicycle lamp, such as the one shown in *Chou*, to switch automatically between separate modes of operation depending on available power. Further still, *Johnson et al.* fails entirely to provide a teaching or suggestion for switching from operation of a primary bulb to a secondary light bulb.

The Examiner's reasoning fails to support the rejection of the pending claims:

The Examiner's reasoning for combining *Chou* and *Johnson et al.* is improper. The Examiner states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the circuitry of *Johnson et al.* for the multifunctional bicycle lamp of *Chou* to provide the safety light continuously even though there is insufficient power for the primary light bulb from the power source (e.g. battery). The bicycle rider can easily notice the change of the light or light intensity at night. Therefore, the rider can take some action before the power in the battery becomes totally empty. It is well known in the art that the low power

consuming LED bulb (Fig. 2, 18) of Chou can be placed in the position of the audio alarm (Fig. 4, 49) of Johnson et al.

This reasoning is improper and fails to provide a *prima facie* case of obviousness. The Background and Summary of the Invention sections of the present specification cite that one of the purposes of the present invention is to provide a safety lamp that operates without intervention by the user. The Examiner improperly cites that "the rider can take some action before the power in the battery becomes totally empty." This "action" clearly refers to the operation of the lamp of *Chou* that requires intervention by the user by the pressing of a switch. Thus, following the Examiner's path of reasoning yields that once a bicycle rider notices a change in light intensity, the rider could then undertake an action by pressing on the switch of the lamp in *Chou* before power in the battery "becomes totally empty." This is precisely one of the operations that the inventive safety lamp of the present invention addresses.

Even if the proposed combination of *Chou* and *Johnson et al.* were made, as admitted by the Examiner in his cited teaching support, the resulting lamp would still require intervention by the user and would still require the user to anticipate that the available power in the battery is diminishing. Both the failure of providing a sensor to monitor power supply and the requirement for intervention by the user provide further support for the Applicant's position that rejections based on the proposed combination of *Chou* and *Johnson et al.* fail to teach or suggest any of the present claims. Accordingly, rejections based upon the proposed combination of *Chou* and *Johnson et al.* should not have been applied and should be removed as moot.

The rejection of claim 8 based upon the *Chou* and *Johnson et al.* references further in view of *Schmidt* is likewise improper since claim 8 depends on claim 1 and inherits the allowable characteristics thereof. *Schmidt* fails entirely to make up for the inadequacies of *Chou* and

Johnson et al. by failing to provide a teaching or suggestion for a sensor that monitors available battery power and switches operation from a primary light to a secondary light to reach the pending claims.

Prima Facie Case Of Obviousness

A prima facie case of obviousness has not been established. As detailed in MPEP § 706.01(j):

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In Re Vaeck, 947 F.2d, 488, 20 USPQ2d 14, 38 (Fed. Cir. 1991).

A prima facie case of obviousness has not been established because there is no suggestion or motivation to combine the references. The burden of establishing a prima facie case of obviousness is initially placed on the Examiner and shifts to the Applicant once a case has been established. After the initial assertion of prima facie case of obviousness, if the Applicant then provides evidence that a prima facie case of obviousness does not exist, the burden to prove the existence of a prima facie case of obviousness shifts back to the Examiner. Here, a prima facie case of obviousness has not been established since the references cited lack a basis upon which the combination can be made as detailed above. Further, even if these references were combined, the claimed invention is not taught or suggested by the combination of references. Any conversion of these applied rejections under 35 U.S.C. § 103(a) to final rejections in response to

this Amendment would be improper absent such express suggestion or teaching in the references.

Accordingly, the rejections applied should be withdrawn.

CONCLUSION

Claims 1-15 are allowable as written and an early notice of such effect is earnestly solicited. Should the Examiner have any questions or comments regarding the foregoing Amendment, he is invited and urged to telephone the undersigned attorney.

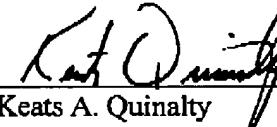
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees that may be required for the timely consideration of this Request for Reconsideration under 37 C.F.R. §§ 1.16 and 1.17, or credit any overpayment to Deposit Account No. 09-0528.

Respectfully submitted

3/9/06

Date


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